UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/944,424	08/30/2001	Ichiro Futamura	09792909-5127	1855

26263 7590 12/21/2006
SONNENSCHEIN NATH & ROSENTHAL LLP
P.O. BOX 061080
WACKER DRIVE STATION, SEARS TOWER
CHICAGO, IL 60606-1080

EXAMINER	
REVAK, CHRISTOPHER A	
ART UNIT	PAPER NUMBER
2131	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/944,424	FUTAMURA ET AL.	
	Examiner	Art Unit	
	Christopher A. Revak	2131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 October 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3,5-14 and 16-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,5-14 and 16-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. In view of the appeal brief filed on October 13, 2006, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-3,5-14, and 16-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-40 of copending Application No. 09/944,192. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3,5-14, and 16-24 of the instant application are envisioned by copending Application No. 09/944,192 in that claims 1-40 of copending Application No. 09/944,192 contains all the limitations of the instant application. Claims 1-3,5-14, and 16-24 of the instant application therefore are not patentably distinct from copending Application No. 09/944,192 claims, and as such, is unpatentable for obvious-type doubling patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claims 1-3,5-14, and 16-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent 7,059,516. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3,5-14, and 16-24 of the instant application are envisioned by U.S. Patent 7,059,516 in that claims 1-24 of U.S. Patent 7,059,516contains all the limitations of the instant application. Claims 1-3,5-14, and 16-

24 of the instant application therefore are not patentably distinct from U.S. Patent 7,059,516 claims, and as such, is unpatentable for obvious-type doubling patenting.

5. Claims 1-3,5-14, and 16-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent 6,990,684. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3,5-14, and 16-24 of the instant application are envisioned by U.S. Patent 6,990,684 in that claims 1-2 of U.S. Patent 6,990,684 contains all the limitations of the instant application. Claims 1-3,5-14, and 16-24 of the instant application therefore are not patentably distinct from U.S. Patent 6,990,684 claims, and as such, is unpatentable for obvious-type doubling patenting.

6. Claims 1-3,5-14, and 16-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 09/943,683. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3,5-14, and 16-24 of the instant application are envisioned by copending Application No. 09/943,683 in that claims 1-30 of copending Application No. 09/943,683 contains all the limitations of the instant application. Claims 1-3,5-14, and 16-24 of the instant application therefore are not patentably distinct from copending Application No. 09/943,683 claims, and as such, is unpatentable for obvious-type doubling patenting.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

7. Claims 1-3,5-14, and 16-24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-22 of U.S. Patent No. 7,100,044. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-3,5-14, and 16-24 of the instant application are envisioned by U.S. Patent No. 7,100,044 in that claims 1-22 of U.S. Patent No. 7,100,044 contains all the limitations of the instant application. Claims 1-3,5-14, and 16-24 of the instant application therefore are not patentably distinct from U.S. Patent No. 7,100,044 claims, and as such, is unpatentable for obvious-type doubling patenting.

Claim Rejections - 35 USC § 101

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claim 24 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claim recites of a "computer readable program medium" which is directed to software alone, and of itself. According to the specification, page 2, lines 3-8, it recites that the software can be distributed via a network such as the Internet or via a storage medium. On page 14, lines 20-24, examples of the medium are given which includes storage medium and one type of storage medium recited is "transmission medium such as a network". In light of the specification, the medium of claim 24 can be transmission media. In order to overcome the issue of non-statutory subject, the examiner notes that the recitation on page 2

distinguishes between the transmission media (network such as the Internet) and storage media, however on page 14, it does not, so to distinguish between the two, the examiner suggests amending the specification on page 14 to recite the types of storage media being CD, FD, etc, and separating the transmission media as a separate type of media from that of the storage media. Additionally, claim 24 will have to be amended to recited of a "computer readable program storage medium". If the applicant is unsure of how to amend the specification, the examiner encourages the applicant to arrange an interview for the examiner to further explain how to amend the specification.

Allowable Subject Matter

10. Claims 1-22 would be allowable if rewritten or amended to overcome the rejections under Obvious-Type Double Patenting and under 35 U.S.C. 101, set forth in this Office action.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher A. Revak whose telephone number is 571-272-3794. The examiner can normally be reached on Monday-Friday, 6:30am-3:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 571-272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CR

December 16, 2006

CHRISTOPHER REVAK
PRIMARY EXAMINER